



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/502,945	02/11/2000	Matthew J. Scanlan	L0461/7081-(JRV)	5906

7590 09/24/2002

John R. Van Amsterdam
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210

EXAMINER

DAVIS, NATALIE A

ART UNIT PAPER NUMBER

1642

DATE MAILED: 09/24/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/502,945

Applicant(s)

SCANLAN ET AL.

Examiner

Natalie A. Davis

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6,37-40 and 57-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37-40 and 62-67 is/are allowed.
- 6) ☒ Claim(s) 6 and 57-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's amendment filed 25 June 2002 (Paper No: 13) is acknowledged.
Accordingly, claims 6, 37-40, and 57-67 are pending and under examination.

Response to Arguments

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Abstract Objection Withdrawn

1. Objection to the abstract is withdrawn in view of amendments.

Claim Rejections - 35 USC § 112 2nd Withdrawn

2. Rejection of claims 6, 37, and 57-67 under 35 U.S.C.112, second paragraph is withdrawn in view of amendments.

Claim Rejections - 35 USC § 112 1st Withdrawn

3. Rejection of claims 6 and 57-61 (paragraph 8), claims 37-40 and 62-67 (paragraph 9), claims 6 and 37-40 (paragraph 10), and claims 6, 37-40, and 57-67 (paragraph 11) under 35 U.S.C.112, first paragraph is withdrawn in view of arguments.

New Claim Rejections - 35 USC § 112 1st

4. Claims 6 and 57-61 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a colon cancer associated antigen and a nucleotide of SEQ ID NO:4, which encodes said colon cancer associated antigen does not reasonably provide enablement for any other cancer associated antigen or SEQ ID NO: 1-3 and 5. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

The claims are drawn to a protein encoded by a nucleic acid, which encodes a cancer associated antigen, wherein the complementary sequence hybridizes to SEQ ID NO: 1-5. The

drop
see
Inc J Cancer
76, 652
Table
1A

Art Unit: 1642

specification discloses the presence of SEQ ID NO: 1-2 in all normal tissue tested, but not in cancer tissue (p. 10, line 3). There is no teaching of SEQ ID NO: 3 and its association with cancer (no data) and no expression of SEQ ID NO: 5 in normal tissue and there is no data present to indicate its expression in cancer. The disclosure shows the presence of SEQ ID NO: 4 in colon tumors and metastasis in gastric renal and colon cell lines and also in normal tissue (Table I, p. 8-9 and example 5). In view of the teaching in the specification, one of ordinary skill in the art would not know how to use SEQ ID NO: 1-3 and 5 or SEQ ID NO: 4 other than as a colon cancer associated antigen.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Davis whose telephone number is 703-308-6410. The examiner can normally be reached on M-F 8-5:30 (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa PhD can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4315 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Natalie A. Davis, PhD
September 23, 2002


SHEELA HUFF
PRIMARY EXAMINER